

REMARKS/ARGUMENTS

Anticipation - Section 102 Rejection

The Examining Attorney has rejected claims 1 through 6 and 8 as being anticipated by Murcko, Jr. (US 6,578,014). The Applicant respectfully requests the Examining Attorney reconsider the rejection based on the arguments set forth below.

The applicant submits that Murcko does not anticipate this invention for at least the following reasons:

1. Murcko is not known or capable of performing the function of this invention. Murcko is an unusual system for attempting to bring buyers and sellers together to agree to make a purchase without first agreeing on a price. Murcko is not capable of, nor does it perform the function of "implementing an on-line incentive program for selected members who are making installment payments. At page 2 the examiner incorrectly indicates that at column 39, lines 60-67, the reference discloses "*identifying at least one selected member making installment payments as a candidate for an incentive program to affect behavior*". The reference to column 39 only indicates that the seller can waive the requirement for payment within a certain amount of time if installment payments are chosen. The reference does not identify an existing member or person who is already making installment payments for an incentive program.

Therefore not only is this element absent, but the reference does not disclose or teach anywhere that it is capable of performing this function.

There is also no disclosure of the claim element of “*providing said selected member notice of eligibility for the incentive program*” disclosed in the Murcko reference. While the Examiner refers to columns 23 & 24, that is an incorrect reference. This claim element is referring to notifying existing members, member who are already registered, notifying them of their eligibility; the reference to columns 23 & 24 only refer to verifying the user is initially registered, and therefore does not also cover the later step of identifying the eligibility of the existing and “selected member” to notify them of their eligibility as an existing installment payment payor. Therefore this element is absent, is not taught or disclosed, and the reference does not disclose that it is capable of performing this function.

The Examiner has not met his burden to establish a *prima facie* case for anticipation on this element.

There is no anticipation by a prior patent not known or recognized as being capable of performing the function of the patented device, but rather the prior patent must itself do the teaching. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (1984); Edstrom-Carson & Co. v. Onsrud Machine Works, Inc., 129 U.S.P.Q. 457.

2. Murcko does not disclose the purpose, means or mechanism that this invention discloses. As stated above, the reference is not directed to an incentive plan for timely installment payments.

There is no anticipation where a reference does not disclose the purpose, means and mechanism for accomplishing the instant invention but rather is restricted to a limited and different means. Sperry Products, Inc. V. Aluminum Company of America, 120 U.S.P.Q. 362.

3. The Murcko reference does not disclose each and every element of the claimed invention, as required for a *prima facie* case of anticipation, and as stated more fully above. Murcko does not provide at least the following elements for the following reasons:

"determining whether said selected member qualifies for one or more non-cash award points based on said selected member payment behavior data". The reference does not clearly set forth that any points or incentives are awarded based on payment behavior. Therefore this element is also missing.

"receiving an enrollment request from said selected member". The reference the Examiner makes to column 23 only refers to verifying if the buyer or seller is still enrolled, and does not refer to or imply receiving an additional enrollment request from one who is already confirmed to be a member, a selected member, who is additionally sending an enrollment

request to be enrolled in an additional program, an incentive program.
Therefore this element is also missing.

Based on these reasons, and on those set forth above with respect to the references not performing the same function, the Murcko reference does not include each and every element, and therefore does NOT support a prima facie case of anticipation.

These arguments apply to claim 1, 3, 4 and 6, and each claim which depends on claim 1 and claim 3, which includes all remaining claims in the patent application.

There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

Prior Art Made of Record and Not Relied Upon


The Applicant notes the prior art made of record but not relied upon and asserts that for the reasons set forth above, the claims are allowable over the art made of record.

Conclusion

Applicant therefore submits Claims 1-6 and 8 are in a position to proceed to allowance.

Respectfully submitted,

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